TRANSMITTAL OF APPEAL BRIEF (Large Entity)	Docket No. END919990104US1

In Re Application OF Constantine et al.	

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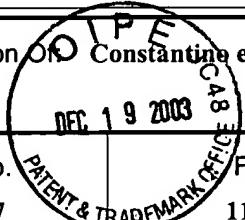
Serial No. 09/449,707	Filing Date 11/24/1999	Examiner Stone, Jonathan D.	Group Art Unit 2178

Invention: **CONTRACT HANDLING METHOD AND SYSTEM**

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Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on **11/25/2003**

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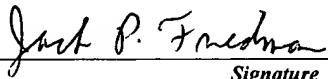
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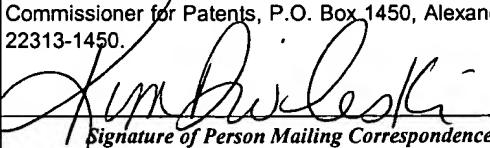
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DOCKET NO. END919990104US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Constantino et al.

Examiner: Stone, Jonathan D.

Serial No.: 09/449,707

Art Unit: 2178

Filed: 11/24/1999

For: **CONTRACT HANDLING METHOD AND SYSTEM**

Commissioner for Patents
P.O. Box 1450
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BRIEF OF APPELLANTS

This Appeal Brief, pursuant to the Notice of Appeal filed November 25, 2003, is an

appeal from the rejection by the Examiner in the Office Action dated August 25, 2003.

REAL PARTY IN INTEREST

International Business Machines, Inc. is the real party in interest.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-21 are currently pending. Claims 1-21 have been rejected. This Brief is in

support of an appeal from the rejection of claims 1-21.

STATUS OF AMENDMENTS

There are no After-Final Amendments which have not been entered.

SUMMARY OF INVENTION

The present invention discloses a contract handling system. The contract handling system comprises an entry tool for entering a client request or a client inquiry. See specification, page 5, lines 8-10. The contract handling system further comprises one or more model agreements and a document assembler for selecting and merging all or part of said one or more model agreements into a contract in response to the client request. See specification, page 5, line 26 - page 6, line 1. The contract handling system further comprises a tracker tool coupled to said entry tool and said document assembler for processing key date reminders and approvals into tracking data. See specification, page 6, lines 24-30. The contract handling system further comprises a repository for storing said contract and said tracking data and for responding to said client inquiry. See specification, page 8, lines 19-20.

The model agreements may be in a plurality of languages. See specification, page 8, lines 3-7.

The tracker tool may be adapted to automatically send said key date reminders to said client via e-mail. See specification, page 7, lines 3-6.

A library of alternate clauses may be accessible by the document assembler. See specification, page 5, lines 26-29.

A library of supplemental provisions may be accessible by the document assembler. See specification, page 5, lines 26-29.

ISSUES

1. Whether claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 are unpatentable under 35 U.S.C. §103(a) over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and in further view of Shirley *et al.* (USPN 5692206).

2. Whether claims 2, 8, and 14 are unpatentable under 35 U.S.C. §103(a) over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and Shirley *et al.* (USPN 5692206) and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).

3. Whether claims 4-5, 10-11, 16-17, and 20 are unpatentable under 35 U.S.C. §103(a) over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and Shirley *et al.* (USPN 5692206) and in further view of Grubb *et al.* (USPN 5272623).

GROUPING OF CLAIMS

Claims 1-21 is divided into groups as shown in Table 1.

Table 1

Group	Claims	Do Claims of Group Stand and Fall Together?
1	1 and 7	Yes
2	13	Yes
3	3, 9, and 15	Yes
4	6, 12, and 18; 4, 10, and 16	Yes
5	5, 11, and 17	Yes
6	2, 8, and 14	Yes
7	19-21	Yes

The claims of Group 2 do not stand and fall together with the claims of Group 1, because of the following issue that is pertinent to the claims of Group 2 but not pertinent to the claims of Group 1: whether Luchs in view of Hoyt and in further view of Shirley teaches or suggests a computer readable medium and program instruction means.

The claims of Group 3 do not stand and fall together with the claims of Groups 1-2, because of the following issue that is pertinent to the claims of Group 3 but not pertinent to the claims of Groups 1-2: whether Luchs in view of Hoyt and in further view of Shirley teaches or suggests automatically sending said key date reminders to the client via e-mail.

The claims of Group 4 do not stand and fall together with the claims of Groups 1-3, because of the following issue that is pertinent to the claims of Group 4 but not pertinent to the

claims of Groups 1-3: whether Luchs in view of Hoyt and in further view of Shirley teaches or suggests a library of supplemental provisions and selection of said supplemental provisions; and whether Luchs in view of Hoyt and Shirley and in further view of Grubb teaches or suggests a library of alternate clauses and selection of said alternate clauses.

The claims of Group 5 do not stand and fall together with the claims of Groups 1-4, because of the following issue that is pertinent to the claims of Group 5 but not pertinent to the claims of Groups 1-4: whether Luchs in view of Hoyt and Shirley and in further view of Grubb teaches or suggests that the alternate clauses are indexed by type of clause.

The claims of Group 6 do not stand and fall together with the claims of Groups 1-5, because of the following issue that is pertinent to the claims of Group 6 but not pertinent to the claims of Groups 1-5: whether Luchs in view of Hoyt and Shirley and in further view of VAN teaches or suggests that the model agreements are in a plurality of languages.

The claims of Group 7 do not stand and fall together with the claims of Groups 1-6, because of the following issue that is pertinent to the claims of Group 7 but not pertinent to the claims of Groups 1-6: whether Luchs in view of Hoyt and in further view of Shirley teach or suggest that the library of model agreements and the library of supplemental provisions is recorded on a computer readable medium; and whether Luchs in view of Hoyt and Shirley and in further view of Grubb teach or suggest that the library of alternate clauses is recorded on a computer readable medium.

ARGUMENT

Issue 1

CLAIMS 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER LUCHS (USPN 4831526) IN VIEW OF HOYT (USPN 6067531) AND IN FURTHER VIEW OF SHIRLEY (USPN 5692206).

The Examiner rejected claims 1, 3, 6-7, 9, 12-13, 15, 18, 19, and 21 under 35 U.S.C.

§103(a) as allegedly being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.*

(USPN 6067531) and in further view of Shirley *et al.* (USPN 5692206).

Claims 1, 7, and 13

Appellants present five examples of why claims 1, 7, and 13 are not unpatentable over

Luchs in view of Hoyt et al. and in further view of Shirley.

First Example (Claims 1, 7, and 13)

As a first example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of

Hoyt and in further view of Shirley, Luchs in view of Hoyt and in further view of Shirley does

not teach or suggest "one or more model agreements" in combination with "a document

assembler for selecting and merging all or part of said one or more model agreements into a

contract" (claim 1); "assembling and merging all or part of said one or more model agreements

into a contract" (claim 7); and "third program instruction means for assembling and merging all

or part of said one or more model agreements into a contract" (claim 13).

The Examiner argues: "Luchs teaches the use of common application forms (col 2, ln 26-

61; compare with "*one or more model agreements*;"). Luchs teaches creating a contract

document by merging stored text selected by a user upon a user's request (col 3, ln 66 - col 4, ln 16; compare with "a document assembler... client request; ")."

In response to the preceding argument by the Examiner, Appellants note that Luchs recites in col. 4, lines 3-19: "This contract is substantially simplified over existing insurance contracts and is created to be custom tailored for the particular client and risk involved.... Thss custom tailoring is achieved by a compiling and editing function in the central processor in which data representing predetermined form **paragraphs** are stored, and those paragraphs which are applicable to the particular insurance contract requested are **selected**. ...These separate and complete paragraphs are then sequenced by the processor for printing in the desired order to yield an insurance contract which is tailored to the client and the risk" (emphasis added). To apply the preceding teaching of Luchs to claims 1, 7, and 13, note that an agreement is a contract (see any dictionary). Appellants respectfully contend that Luchs's system does not include model agreements (i.e., model contracts) as required by claims 1, 7, and 13, but instead includes a database of stored paragraphs, such that an insurance agreement (i.e., insurance contract) may be formed from the selection of particular paragraphs from the database of paragraphs.

In the Examiner's "Response to Arguments", the Examiner argues: "Luchs does not preclude the use of said predetermined paragraphs as model agreements. It was known at the time of the invention that agreements and contracts appeared in various sizes and lengths. It is not unreasonable to assert that an entire agreement or contract may have been comprised in one paragraph, such as the paragraphs taught by Luchs."

In response to the preceding argument by the Examiner in "Response to Arguments", Appellants respectfully contend Luchs **always** refers to "paragraphs" in the **plural form** when

disclosing the grouping of paragraphs to for an insurance contract. See, e.g., Luchs, col. 4, lines 15-19: "These separate and complete paragraphs are then sequenced by the processor for printing in the desired order to yield an insurance contract which is tailored to the client and the risk." Luchs **never** refers to an insurance contract as consisting of only one of said paragraphs. Thus, Appellants respectfully suggest that the Examiner's assumption that one of Luch's stored paragraphs could be a complete contract is unsupported speculation.

Second Example (Claims 1, 7, and 13)

As a second example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "a document assembler for selecting and merging all or part of said one or more model agreements into a contract in response to said client request" (claim 1); "assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool" (claim 7); and "third program instruction means for assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool" (claim 13). As explained *supra* in conjunction with the First Example, Luchs selects and merges individual paragraphs to form an insurance contract, while claims 1, 7, and 13 recite selection and merging of model agreements to form a contract.

In "Response to Arguments", the Examiner argues: "Luchs' paragraphs may be model agreements themselves. In such a case, the selecting and merging of individual paragraphs would read on the selecting and merging of model agreements as claimed".

In response to the preceding argument by the Examiner in "Response to Arguments",

Appellants reiterate that an individual paragraph is not a model agreement, as explained *supra* in conjunction with the First Example.

Third Example (Claims 1, 7, and 13)

As a third example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest "a repository for storing said contract and said tracking data and for responding to said client inquiry" (claim 1); "storing said contract and said tracking data in a repository" (claim 7); and "fifth program instruction means for storing said contract and said tracking data in a repository" (claim 13).

The Examiner argues: "Luchs also discloses storing the contract and associated data in a repository (col 4, ln 28-31; compare with *"a repository... inquiry. ")."*

In response, Appellants respectfully contend that col. 4, lines 28-31 of Luchs teaches: "the information included in the original application is electronically stored", which is not what claims 1, 7, and 13 require. Luchs teaches storing "information included in the original application". In contrast, claim 1 requires storing the **contract** and said **tracking data**. In fact, Luchs does not even disclose tracking data, as admitted by the Examiner. Thus, the Examiner's argument relating the preceding feature of claims 1, 7, and 13 in the third example is not persuasive.

In "Response to Arguments" in the office action, the Examiner argues: "The Office admits that Luchs does not explicitly teach tracking data and the storage of that tracking data. The Office contends that Luchs does teach the storage of the contract as per Luchs teaching of

"the information included in the original application is electronically stored and displayed". Hoyt, however, teaches keeping track of information associated with contracts, such as approvals, as per the rejection of claim 1 above. Hoyt teaches such information being stored in repositories (col 8, In 33-42). When combined with Luchs it would have been obvious to one of ordinary skill in the art at the time of the invention to include a repository in which to store the tracking information associated with the contract. Not storing the information in memory would have defeated the purpose of tracking the status of the contract since the contract itself would have had to be looked at every time a status query was made.".

In response to the preceding argument by the Examiner in "Response to Arguments", Appellants respectfully contend that it is not obvious to modify Luchs to include a repository in which to store the tracking information associated with the contract, because Luchs is concerned only with processing insurance applications and generating insurance contracts therefrom. Luchs is not concerned with tracking information associated with the generated insurance contracts. Therefore, modifying Luchs as suggested by the Examiner is not relevant to the purpose of Luchs' invention and is thus not obvious.

Fourth Example (Claims 1, 7, and 13)

As a fourth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley, Appellants respectfully maintain that the Examiner's argument for modifying Luch's invention with Hoyt (for approvals) and Shirley (for key date reminders) is not persuasive.

The Examiner argues: "It would have been obvious to one of ordinary skill in the art at

the time of the invention to modify Luchs' invention to include means for tracking the approval

status and important dates associated with a contract, including storing the tracking information

in a repository. Such a modification would have given an agent generating a contract more

flexibility. Allowing a client to fill in clauses appropriate for the client and further allowing the

agent to track the document's status and associated dates would have alleviated a communication

burden if negotiating was necessary. Storing the tracking information would have allowed a user

to check the contract's status with requiring the contract itself to check"

In response, Appellants observe the following teaching in col. 2, lines 14-18 of Shirley:

"The present invention also provides auxiliary documents which are related to the negotiated

contract documents such as payment schedules, due date schedules, termination dates, and other

tasks which accompany the execution of a contract". A review of the preceding dates disclosed

in Shirley reveals that said dates disclosed in Shirley relate essentially to events which will occur

after the contract has been generated and not to events that support the contract generation

process. However, Luch's invention is concerned essentially with the contract generating

process and not with events occurring after the contract has been generated. Therefore, Shirley's

dates are not relevant to Luch's invention. Accordingly, it would not be obvious to a person of

ordinary skill in the art to modify Luch's invention by adding Shirley's means for tracking dates.

In "Response to Arguments", the Examiner argues: "Luchs teaches displaying an

application (i.e. contract) for the purpose of approval/disapproval (col 2, ln 43-46). It would have

been obvious to one of ordinary skill in the art at the time of the invention to combine Luchs with

Hoyt, arriving at a more flexible contract generation system that is easier for users to use. It also

would have been obvious to one of ordinary skill in the art at the time of the invention to

combine Shirley with Luchs and Hoyt, arriving at a contract generation system that maintains the general document construction method but provides a user with greater customization of documents and more expands on the supplemental contract-associated information provided by Hoyt.".

In response to the preceding argument by the Examiner in "Response to Arguments", Appellants respectfully contend that Luchs, col. 2, lines 43-46 does not teach "displaying an application (i.e. contract) for the purpose of approval/disapproval" as alleged by the Examiner. Rather, Luchs, col. 2, lines 43-46 teaches a reinstatement file to facilitate entry of a reinstatement order. Importantly, the reinstatement mechanism disclosed in Luchs, col. 2, lines 43-46 is simple and apparently works without the need to add the unnecessary complexity of Shirley's tracking dates. Thus it is not obvious to modify Luchs with Shirley's tracking dates.

Fifth Example (Claims 1, 7, and 13)

As a fifth example of why claims 1, 7, and 13 are not unpatentable over Luchs in view of Hoyt and in further view of Shirley, Luchs in view of Hoyt and in further view of Shirley does not teach or suggest: "a tracker tool coupled to said entry tool and said document assembler for processing key date reminders and approvals into tracking data" (claim 1); "processing key date reminders and approvals into tracking data" (claim 7); and "fourth program instruction means for processing key date reminders and approvals into tracking data" (claim 13).

While the Examiner has made arguments relating to the storing of tracking data and the tracking of dates, the Examiner has made not made any argument relating to **processing** key date reminders and approvals **into tracking data**" (emphasis added), as required by claims 1, 7, and

13.

Based on the preceding fifth example, Appellants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 1, 7, and 13.

Claim 13: Additional Argument

With respect to claim 13, the Examiner argues: " The use of a computer readable medium on which to store program instructions, program products, and other data was known and typical at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a computer readable medium in the invention described in the rejection of claim 1. This would have provided the invention with local access to program instructions to implement the invention as well as access to databases and storage areas."

In response, Appellants contend that the preceding argument by the Examiner is not persuasive because the Examiner's argument is generic and non-specific. In particular, the Examiner has not offered any argument that relates specifically to Luchs' invention. If the Examiner is permitted to offer a generic, non-specific argument without any consideration of the specifics of Luchs' invention, then the Examiner would be able to use such an argument with respect to *any invention* for which it is theoretically possible to use a computer readable medium, processor, computer storage, databases, etc. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claim 13.

Claims 3, 9, and 15

Since claims 3, 9, and 15 depend from claims 1, 7, and 13, respectively, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 3, 9, and 15 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants maintain that Luchs in view of Hoyt and in further view of Shirley do not teach or suggest "wherein said tracker tool is adapted to automatically send said key date reminders to said client via e-mail" (claim 3); "further comprising automatically sending said key date reminders to said client via e-mail" (claim 9); and "wherein said fourth program instruction means is adapted to automatically send said key date reminders to said client via e-mail" (claim 15).

The Examiner argues: "Luchs does not explicitly disclose automatically sending key date reminders to a client via e-mail. However, Hoyt discloses distributing documents to users after the status of the document is changed (col 15, ln 30-35). The use of electronic mail to distribute documents throughout a network was known and typical at the time of the invention. Shirley teaches incorporating an e-mail control unit for contract distribution (col 2, ln 57-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the tracking tool as described in the rejection of claim 1 to send documents, including tracked information like key dates, through e-mail means. Such a modification would have improved user interface and access by delivering important documents through familiar means."

As a first example why the preceding argument by the Examiner is not persuasive, Appellants contend that Luchs is concerned with the efficient generation of an insurance policy, but is not concerned with sending key date reminders to insurance clients. Thus, the Examiner's

reason for modifying Luchs with Hoyt is not relevant to the purpose of Luchs' invention.

As a second example why the preceding argument by the Examiner is not persuasive, Appellants contend that the Examiner's argument with respect to Shirley is an improper modification of the secondary reference of Hoyt. The Examiner argues that the primary reference of Luchs discloses a an insurance contract generation system. The Examiner also argues that the secondary reference of Hoyt has modified the primary reference of Luchs, by alleging that Hoyt teaches or suggests distributing documents to users after the status of the document is changed. The Examiner additionally argues that the secondary reference of Shirley has modified the secondary reference of Hoyt, by alleging that Shirley teaches or suggests using e-mail for distributing said documents (having changed status) to users. Appellants maintain that it is improper to argue that a claim feature is taught or suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Appellants respectfully maintain that the rejection of claims 3, 9, and 15 under 35 U.S.C. §103(a) is improper and should be withdrawn.

Claims 6, 12, and 18

Since claims 6, 12, and 18 depend from claims 1, 7, and 13, respectively, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 6, 12, and 18 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants maintain that Luchs in view of Hoyt and in further view of Shirley do not teach or suggest "further comprising a library of supplemental provisions, accessible by said document assembler" (claim 6); "further comprising selecting a supplemental provision from a library of supplemental provisions and merging said supplemental provision into said contract" (claim 12); and "further comprising program instruction means for selecting a supplemental provision from a library of supplemental provisions and merging said supplemental provision into said contract" (claim 18).

The Examiner argues "Luchs does not explicitly disclose a library of supplemental provisions. However, Shirley discloses the use of additional provisions for generating contracts (col 2, ln 11-14). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the teaching of Shirley to the invention disclosed by Luchs. This would have given a user more opportunity for tailoring a contract to his or her needs."

In response to the preceding argument by the Examiner, Appellants contend that Shirley's "supplemental provisions" are essentially the same as Luchs' paragraphs. Therefore, there is no need to modify Luchs by Shirley to add supplemental provisions which Luchs already discloses as paragraphs. In other words, Shirley's supplemental provisions adds nothing to Luchs' invention.

Claims 19 and 21

Since claims 19 and 21 depend from claims 13, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 19 and 21 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants maintain that Luchs in view of Hoyt and in further view of Shirley do not teach or suggest "wherein said library of model agreements is recorded on said medium" (claim 19); and "wherein said library of supplemental provisions is recorded on said medium" (claim 21).

The Examiner argues: "Regarding dependent claims 19 and 21, Luchs, Hoyt, and Shirley do not explicitly disclose recording a library of model agreements or supplemental provisions on a computer readable medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries."

In response, Appellants contend that the preceding argument by the Examiner is not persuasive because the Examiner's argument is generic and non-specific. In particular, the Examiner has not offered any argument that relates specifically to Luchs' invention. If the Examiner is permitted to offer a generic, non-specific argument without any consideration of the specifics of Luchs' invention, then the Examiner would be able to use such an argument with respect to *any invention* for which it is theoretically possible to use a computer readable medium. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claims 19 and 21.

Issue 2

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CLAIMS 2, 8, and 14 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER LUCHS (USPN 4831526) IN VIEW OF HOYT (USPN 6067531) AND SHIRLEY (USPN 5692206) AND IN FURTHER VIEW OF "FREQUENTLY ASKED QUESTIONS ABOUT YOUR VIRTUAL AGENT NETWORK FOR WORLD WIDE BUSINESS".

The Examiner rejected claims 2, 8, and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and Shirley *et al.* (USPN 5692206) and in further view of "Frequently Asked Questions about Your Virtual Agent Network for World Wide Business" (herein VAN; Australian American Chamber of Commerce, 1996).

Since claims 2, 8, and 14 depend from claims 1, 7, and 13, respectively, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 2, 9, and 14 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Luchs in view of Hoyt and Shirley in further view of VAN do not teach or suggest "wherein said model agreements are in a plurality of languages".

The Examiner argues "Luchs does not explicitly disclose model agreements in a plurality of languages. However, VAN teaches an invention for assisting users in buying and selling goods and negotiating the exchange of said goods. VAN discloses the use of the invention in multiple languages to cater to a global market (pg 1-2 and 16-17). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Luchs and VAN. Such a combination would have opened the use of Luchs' contract builder to a global market, instantly increasing the breadth of the invention."

In response, Appellants contend that the preceding argument by the Examiner is not persuasive for at least the following two reasons.

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The first reason is that VAN does not disclose model agreements in a plurality of languages as required by claims 2, 8, and 14. Instead, VAN discloses (on page 17, lines 1-5) having software in a plurality of languages for negotiation purposes and not for contract generation purposes. Therefore, the feature of "wherein said model agreements are in a plurality of languages" is not disclosed by either Luchs or VAN.

The second reason is that Luchs does not disclose any hint or suggestion of a need for model agreements in a plurality of languages. Therefore, the Examiner's argument for combining VAN with Luchs is no more than hindsight reconstruction, which is legally impermissible.

Issue 3

CLAIMS 26 AND 29-35 ARE NOT UNPATENTABLE UNDER 35 U.S.C. §103(a) OVER LUCHS (USPN 4831526) IN VIEW OF HOYT (USPN 6067531) AND SHIRLEY (USPN 5692206) AND IN FURTHER VIEW OF GRUBB (USPN 5272623).

The Examiner rejected claims 4-5, 10-11, 16-17, and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Luchs *et al.* (USPN 4831526) in view of Hoyt *et al.* (USPN 6067531) and Shirley *et al.* (USPN 5692206) and in further view of Grubb *et al.* (USPN 5272623).

Claims 4, 10, and 16

Since claims 4, 10, and 16 depend from claims 1, 7, and 13, respectively, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claims 4, 10, and 16 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Luchs in view of Hoyt and Shirley in further view of Grubb do not teach or suggest "further comprising a library of alternate clauses, accessible by said document assembler" (claim 4); "further comprising selecting one or more alternate clauses from a library of alternate clauses and replacing part of said selected one or more model agreements with said one or more alternate clauses" (claim 10); and "further comprising sixth program instruction means for selecting one or more alternate clauses from a library of alternate clauses and replacing part of said selected one or more model agreements with said one or more alternate clauses" (claim 16).

The Examiner argues: "Luchs does not explicitly disclose a library of alternate clauses. However, Grubb discloses maintaining a database of Government Agency Regulation clauses (GARCs) for insertion into a contract document (col2, ln 10-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the two inventions to create a contract document creator with more options for a user. A database of clauses would have given a user more opportunity for tailoring a contract to his or her needs."

In response to the preceding argument by the Examiner, Appellants contend that Grubb's "alternate clauses" are essentially the same as Luchs' paragraphs. Therefore, There is no need to modify Luchs by Grubb to add alternate clauses which Luchs already discloses as paragraphs. In other words, Grubb's alternate clauses adds nothing to Luchs' invention.

Claims 5, 11, and 17

Since claims 5, 11, and 17 depend from claims 4, 10, and 16, respectively, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that

claims 5, 11, and 17 are not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants contend that Luchs in view of Hoyt and Shirley in further view of Grubb do not teach or suggest " wherein said library of alternate clauses is indexed by type of clause" (claim 5); "wherein said one or more alternate clauses are selected from a library of alternate clauses indexed by type of clause" (claim 11); and "wherein said one or more alternate clauses are selected from a library of alternate clauses indexed by type of clause" (claim 17).

The Examiner argues that "sorting libraries was common and typical in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to organize the clause library by type. This would have presented a more logical organization for users to access and find what they needed in the library".

In response, Appellants contend that the preceding argument by the Examiner is insufficient because the Examiner has not cited a prior art reference that teaches or suggests indexing the alternate clauses by type of clause, as required by claims 5, 11, and 17. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claims 5, 11, and 17.

Claim 20

Since claim 20 depends from claim 13, which Appellants have argued *supra* to be patentable under 35 U.S.C. §103(a), Appellants maintain that claim 20 is not unpatentable under 35 U.S.C. §103(a).

In addition, Appellants maintain that Luchs in view of Hoyt and Shirley in further view of

Grubb do not teach or suggest "wherein said library of alternate clauses is recorded on said medium".

The Examiner argues: "Regarding dependent claim 20, Luchs, Hoyt, Shirley, and Grubb do not explicitly disclose recording a library of alternate clauses on a medium. However, it was known and typical at the time of the art to store libraries on a computer readable medium accessible to an application associated with said libraries. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the library on a computer readable medium accessible to the current invention. This would have provided a user with easy access to the libraries."

In response, Appellants contend that the preceding argument by the Examiner is not persuasive because the Examiner's argument is generic and non-specific. In particular, the Examiner has not offered any argument that relates specifically to Luchs' invention. If the Examiner is permitted to offer a generic, non-specific argument without any consideration of the specifics of Luchs' invention, then the Examiner would be able to use such an argument with respect to *any invention* for which it is theoretically possible to use a computer readable medium. Accordingly, Appellants respectfully maintain that the Examiner has not satisfied the Examiner's burden of proof to establish a *prima facie* case of obviousness in relation to claim 20.

SUMMARY

In summary, Appellants respectively request reversal of the rejection of claims 1-21 under 35 U.S.C. §103(a) in the office action mailed August 25, 2003.

Respectfully submitted,

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09/449,707   23

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Constantino et al.

Examiner: Stone, Jonathan D.

Serial No.: 09/449,707

Art Unit: 2178

Filed: 11/24/1999

For: **CONTRACT HANDLING METHOD AND SYSTEM**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPENDIX - CLAIMS ON APPEAL

1. A contract handling system, comprising:

an entry tool for entering a client request or a client inquiry;

one or more model agreements;

a document assembler for selecting and merging all or part of said one or more model

agreements into a contract in response to said client request;

a tracker tool coupled to said entry tool and said document assembler for processing key

date reminders and approvals into tracking data; and

a repository for storing said contract and said tracking data and for responding to said

client inquiry.

2. The contract handling system of claim 1, wherein said model agreements are in a plurality of

languages.

3. The contract handling system of claim 1, wherein said tracker tool is adapted to automatically

send said key date reminders to said client via e-mail.

4. The contract handling system of claim 1, further comprising a library of alternate clauses, accessible by said document assembler.

5. The contract handling system of claim 4, wherein said library of alternate clauses is indexed by type of clause.

6. The contract handling system of claim 1, further comprising a library of supplemental provisions, accessible by said document assembler.

7. A method of handling contracts, comprising the steps of:

    entering a client request into an entry tool;

    selecting one or more model agreements from a library of model agreements;

    assembling and merging all or part of said one or more model agreements into a contract

in response to said client request in said entry tool;

    processing key date reminders and approvals into tracking data; and

    storing said contract and said tracking data in a repository.

8. The method of handling contracts of claim 7, wherein said model agreements are selected from model agreements in a plurality of languages.

9. The method of handling contracts of claim 7, further comprising automatically sending said key date reminders to said client via e-mail.

10. The method of handling contracts of claim 7, further comprising selecting one or more alternate clauses from a library of alternate clauses and replacing part of said selected one or more model agreements with said one or more alternate clauses.

11. The method of handling contracts of claim 10, wherein said one or more alternate clauses are selected from a library of alternate clauses indexed by type of clause.

12. The method of handling contracts of claim 7, further comprising selecting a supplemental provision from a library of supplemental provisions and merging said supplemental provision into said contract.

13. A computer program product for instructing a processor to handle a contract, said computer program product comprising:

a computer readable medium;

first program instruction means for entering a client request into an entry tool;

second program instruction means for selecting one or more model agreements from a library of model agreements;

third program instruction means for assembling and merging all or part of said one or more model agreements into a contract in response to said client request in said entry tool;

fourth program instruction means for processing key date reminders and approvals into tracking data; and

fifth program instruction means for storing said contract and said tracking data in a repository, wherein all said program instruction means are recorded on said medium.

14. The computer program product of claim 13, wherein said model agreements are in a plurality of languages.

15. The computer program product of claim 13, wherein said fourth program instruction means is adapted to automatically send said key date reminders to said client via e-mail.

16. The computer program product of claim 13, further comprising sixth program instruction means for selecting one or more alternate clauses from a library of alternate clauses and replacing part of said selected one or more model agreements with said one or more alternate clauses.

17. The computer program product of claim 16, wherein said one or more alternate clauses are selected from a library of alternate clauses indexed by type of clause.

18. The computer program product of claim 13, further comprising program instruction means for selecting a supplemental provision from a library of supplemental provisions and merging said supplemental provision into said contract.

19. The computer program product of claim 13, wherein said library of model agreements is recorded on said medium.

20. The computer program product of claim 16, wherein said library of alternate clauses is recorded on said medium.

21. The computer program product of claim 18, wherein said library of supplemental provisions is recorded on said medium.